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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,595	05/19/2000	Michael Bundy	T30418US	7510

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HOUSTON, TX 77253-3267

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/574,595

Applicant(s)

BUNDY, MICHAEL

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 18-40 is/are pending in the application.
- 4a) Of the above claim(s) 25-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in response to the Applicant's communication filed on May 16, 2005. Claims 1-8 and 18-40 are pending. Claims 25-40 have been withdrawn from consideration as discussed in the last office action. Applicants in replying to this office action are respectfully advised to cancel the non-elected withdrawn claims. Claims 1-8 and 18-24 have been examined. The rejections and response to arguments are stated below.

Response to Arguments regarding Restriction/Election

2. With respect to groupings of claims the reasons for restricting the claims into the categories have been presented in the last office action. However for the sake of clarity the following additional information is presented. Even though all the groupings are classified in the same class and subclass, the inventions are separate as discussed in the last office action. Business methods being a relatively new technology from the standpoint of patents, several separate subcategories are grouped together in the same subclass even though one with ordinary skill in the art would clearly delineate these subcategories as warranting separate subclasses. Hence different fields of search are warranted. Unlike other art units, in Business methods a significant amount of the search is in non-patent literature. The statement by the applicants that "it appears to the Applicants that the scope of search would in fact be the same for all groups" is not a test of "serious burden" imposed on the examiner.

Accordingly the Examiner maintains the restriction of claims made in the last office action. Claims 25-40 are withdrawn from consideration as being drawn to the non-elected group. Applicants in replying to this office action are respectfully advised to cancel the non-elected withdrawn claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-7, 17, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US Patent 5,864,827) in view of Cuomo et al (US Patent 6,272,539 B1) as discussed in paragraph 6 of the last office action.

5. Claims 2, 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US Patent 5,864,827) in view of Cuomo et al (US Patent 6,272,539 B1) and further in view of Grochowski et al (US Patent 6,035,389) as discussed in paragraph 7 of the last office action.

6. Claims 18, 19, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US Patent 5,864,827) in view of Cuomo et al (US Patent 6,272,539 B1) and further in view of Patterson Jr. et al (US Patent 5,915,245) as discussed in paragraph 8 of the last office action.

Response to Arguments

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Cuomo and Wilson are concerned with the problem of communication over a network between a user and another network user (such as a server or a market). Hence it would have been obvious to one with ordinary skill in the art at the time of the current invention modify Wilson to include the teaching of Cuomo. The combination of the disclosures taken as a whole suggests users would have benefited from having information about network delays so that they may make informed decisions about further course of action.

In response to Applicant's arguments that Wilson fails to teach a display format the examiner respectfully disagrees. For instance Figure 1 of Wilson discloses interfaces for displaying the pertinent information. Support for interfaces for receiving and sending orders are found throughout Wilson's disclosure.

In response to Applicant's arguments that Wilson fails to teach displaying multiple markets the examiner respectfully disagrees. For instance Figure 1 of Wilson discloses interfaces for displaying the pertinent information and Figure 3 of Wilson discloses multiple markets including TSE and NYSE. Plurality of markets includes two different markets and the device of Wilson includes I/O device for display of pertinent information.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "identifying which markets are likely to execute orders more quickly than others") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations

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from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's arguments that Cuomo fails to teach or suggest displaying latencies for different markets the examiner respectfully disagrees. Cuomo teaches the steps of recording the time when each message is sent, recording for responses received from recipient of the message the time when each response is received, wherein each response corresponds to a particular message, calculating for a recipient a latency dependent upon at least one recorded time when at least one message is sent to the recipient and at least one recorded time when a corresponding response is received from the recipient and displaying the latency for the recipient. (See Cuomo abstract, Column 3 lines 11-16, 28-35, Column 3 line 44 – Column 4 line 21, Claims 1-3). The network sites are interpreted to include different markets. The identity of the different network sites is inherent in the disclosure of Cuomo.

In response to Applicant's arguments about claim 2 that Grochowski fails to teach latency associated with a port the examiner respectfully disagrees. Grochowski teaches latency for a port (See Grochowski abstract, Column 2 lines 19-25).

In response to Applicant's arguments about claim 8 that Cuomo fails to teach, "counting the number of messages sent to a market through a port", the examiner respectfully disagrees. Figure 6C shows a tally of messages experiencing various lengths of delay. Cuomo also discloses in Column 13 lines 21-42, about using a wide variety of graphs to display the information. In Column 13 line 65 – Column 14 line 5 Cuomo discloses using numerical counters to provide a count of messages.

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In response to Applicant's arguments about claim 18 that Patterson uses "status" of previous orders to select a market, the examiner concurs with the Applicants. Status refers to the stage of the transaction. In Column 19 lines 2-37, Patterson discloses using volley codes to define the present stage of the transaction. Patterson also discloses in the cited portion "other characters or digital means may be used to identify the progression of a communication from one device to another". These teachings clearly imply that selection of markets is based on latencies also.

Applicant's other arguments with respect to claims 1-8 and 18-24 have been considered but are not persuasive.

Conclusion

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is

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(571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian
September 8, 2005



Jagdish N. Patel
Primary Examiner